

REMARKS

In response to the Office Action dated February 9, 2004, Applicant respectfully requests reconsideration based on the above amendment and following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

Claims 6-13 and 17-20 were rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. The Examiner appears to suggest that the web interface is not adequately described in the specification. Applicant respectfully disagrees that the web interface is not adequately disclosed in the specification. However, this feature has been eliminated from the claims rendering this rejection moot.

Claims 6 and 17 were rejected under 35 U.S.C. § 112, second paragraph. These claims have been amended to address the items raised by the Examiner.

Claims 14-16 were rejected under 35 U.S.C. § 102(e) as being anticipated by Okun. This rejection is respectfully traversed for the following reasons.

Claim 14 recites "a home location register for storing a profile of a user of a telecommunications device, wherein the profile includes an indication of whether the user is a subscriber to an incoming call hold service implemented by the telecommunications system . . . determining whether an incoming call placed to the telecommunications device by a calling party should be placed on hold prior to the call being answered by the user of the telecommunications device according to the incoming call hold service." In claim 14, the determination of whether to place a call on hold is based on the user's profile. The user need not interact with the phone to place a call on hold. The system automatically determines whether the user subscribes to the hold service and places a call on hold if appropriate.

Okun does not teach these features. In Okun, the user presses keys to either answer a call or place a caller on hold (see paragraph [0061]). Thus, the determination of whether to place a call on hold is based on user input. This is contrary to claim 14 that determines whether to place a call on hold based on a user profile.

For at least the above reasons, claim 14 is patentable over Okun. Claims 15 and 16 depend from claim 14 and are patentable over Okun for at least the reasons advance with respect to claim 14.

New claims 21 and 22 recite that the parameters of the hold function are received via a web interface. The Examiner had rejected claims 6 and 17 under 35 U.S.C. § 112, first paragraph as failing to meet the written description requirement. Applicant did have possession of this feature upon filing of the application and the rejection based on the written description requirement is improper.

As noted in MPEP § 2163, the first paragraph of 35 U.S.C. 112 requires that the "specification shall contain a written description of the invention * * *." This requirement is separate and distinct from the enablement requirement. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1560, 19 USPQ2d 1111, 1114 (Fed. Cir. 1991). >See also *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 920-23, 69 USPQ2d 1886, 1890-93 (Fed. Cir. 2004) (discussing history and purpose of the written description requirement); *In re Curtis*, 354 F.3d 1347, 1357, 69 USPQ2d 1274, 1282 (Fed. Cir. 2004) ("conclusive evidence of a claim's enablement is not equally conclusive of that claim's satisfactory written description").< The written description requirement has several policy objectives. "[T]he 'essential goal' of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed." *In re Barker*, 559 F.2d 588, 592 n.4, 194 USPQ 470, 473 n.4 (CCPA 1977). Another objective is to put the public in possession of what the applicant claims as the invention. See *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1566, 43 USPQ2d 1398, 1404 (Fed. Cir. 1997), *cert. denied*, 523 U.S. 1089 (1998). To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.

In the present, the Applicant clearly had possession of the "web interface" embodiments upon filing of the application. The web interface is described in Applicant's specification in paragraph [0048] along with other interfaces. Thus, possession of these embodiments upon filing is clearly established by the original specification.

The Examiner notes that the drawings do not depict a web interface, but no objection to the drawings has been raised. If the Examiner desires an alteration to the drawings, Applicant is agreeable to amending the drawings to add the web interface, as this feature is clearly supported in the original specification and would not be new matter.

In view of the foregoing remarks and amendments, Applicant submits that the above-identified application is now in condition for allowance. Early notification to this effect is respectfully requested.

If there are any charges with respect to this response or otherwise, please charge them to Deposit Account 06-1130.

Respectfully submitted,

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